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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,174	05/24/2000	Ravi V. Condamoor	NH-2	5012
23933	7590	05/18/2004	EXAMINER	
STUART T AUVINEN 429 26TH AVENUE SANTA CRUZ, CA 95062-5319			POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,174

Applicant(s)

CONDAMOR ET AL.

Examiner

Frantzy Poinvil

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NY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 25-28 is/are allowed.
- 6) ☒ Claim(s) 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-24 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly an abstract idea.

Applicant argues that the present invention in referring to claims 12-24 recites “computer-implemented” method and thus contains sufficient language to bring the claims into statutory basis.

In response, the Examiner respectfully disagrees with applicant’s assertion. Applicant’s assertion is in contradiction with current mandate and reliance on recent court decisions. The instant claims 12-24 lack a practical application in the technological arts. The claims as recited fail to include the guidelines established by the Federal Circuit in the *State Street Bank* decision in which it was established that a statutory claim must recite a practical application in the technological arts. Further support by the Examiner is found in *In re Toma* where it is sated “ ‘technological arts’ or ‘useful’ arts inquiry must focus on whether claimed subject matter, for example, method operating machine to translate, is statutory, not on whether product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example whether it ‘enhances’ operation of machine; this was the law prior to *Gottschalk v.*

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Benson, 175 USPQ 673, and was not changed by Benson.” (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that ...all that is necessary to make a sequence of operational steps a statutory ‘process’ within 35 USC 101 is that it built in the technological arts so as to be in consonance with Constitutional purpose to promote progress of ‘useful arts’...” (emphasis added).

In the instant claims the term “computer-implemented” is only a trivial usage. The claims do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. The claimed invention further does not include any transformation and thus no practical application in the technological arts exists.

Consequently, the claims remain to be analyzed based upon the underlying process, and are remain to be rejected as being directed to a non-statutory subject matter.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Claims 1-28 are allowable over the art of record as stated in the prior Office action.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 Before Final rejection and (703) 872-9327 for After Final rejection.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
May 4, 2004


FRANTZY POINVIL
PATENT EXAMINER
AU 3628